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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,847	04/06/2006	Masaki Tsujimoto	062289	5518

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
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WASHINGTON, DC 20036

EXAMINER
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MCCLELLAND, KIMBERLY KEIL

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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11/09/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,847	<b>Applicant(s)</b> TSUJIMOTO ET AL.	
	<b>Examiner</b> KIMBERLY K. MCCLELLAND	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09/01/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/28/09 has been entered.

### ***Response to Amendment***

2. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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possession of the claimed invention. The newly added phrase in independent claim 1 of “supporting means in accordance with the size of the ring frame” appears to be new matter. This language could not be found in the specification as originally filed. The drawings do not illustrate this feature. Clarification is required. Claim 2 is rejected based on dependency to independent claim 1.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase in independent claim 1 of “supporting means in accordance with the size of the ring frame” is unclear. It is unclear what structural relationship is defined by the term “in accordance”. The ring frame is not currently recited as a component of claimed apparatus (only the supporting means, precutting means, peeling plate, and pressing roller are positively recited). It is unclear how the apparatus may be defined in terms of its contents. Clarification is required. Claim 2 is rejected based on dependency to independent claim 1.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over International Application Publication No. WO00/15354 to Okada et al. as cited in U.S. Patent No. 6,500,291 in view of U.S. Patent No. 5,961,768 to Tsujimoto.

9. With respect to claim 1, the terms “supporting means”, and “pre-cutting means” are being treated under 35 U.S.C. 112, sixth paragraph. Okada et al. discloses a lamination device, including supporting means (2) for supporting a strip material including a film corresponding to the dicing tape stuck on a surface of a base sheet; pre-cutting means (3; See Figure 3) for forming a cut in said film of said strip material fed from the supporting means in accordance with the size of the ring frame, thereby forming the dicing tape; peeling roller (5) for peeling off said dicing tape from said base sheet, the peeling roller being located downstream of said pre-cutting means in the sheet feeding direction; and a press roller (9/10) positioned at the downstream end of said peeling roller in the sheet feeding direction for pressing the dicing tape onto the ring frame (See Figures 1 and 14). Okada et al. does not specifically disclose a peeling plate.

10. Tsujimoto discloses an apparatus for applying adhesive sheets, including it is known in the art as equivalent to substitute a peel plate for a peeling roller (column 2, lines 45-48; See Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the equivalent peeling plate for the peeling roller taught by Okada. Simple substitution of one known peeling device for another would produce the predictable result of effectively peeling a carrier layer.

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11. 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.” Therefore, the cutter (B; Figure 3) taught by Okada et al. reads on die cutter recited in the current claim language because the features are drawn to an equivalent structure which performs the same function as the recited pre-cutting means and peeling means under 35 U.S.C. 112, sixth paragraph.

12. Examiner notes the phrases, “for supporting a strip material including a film corresponding to the dicing tape stuck on a surface of a base sheet”, “for forming a cut in said film of said strip material fed from the supporting means in accordance with the size of the ring frame, thereby forming the dicing tape”, “for forming a dicing tape by forming a cut in said film in accordance with the size of said ring frame to the strip material fed from the supporting means”, “for peeling off said dicing tape from said base sheet, the peeling roller being located downstream of said pre-cutting means in the sheet feeding direction” and “for pressing the dicing tape onto the ring frame” are considered intended use language of the currently claimed apparatus. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim

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containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over International Application Publication No. WO00/15354 to Okada et al. as cited in U.S. Patent No. 6,500,291 in view of U.S. Patent No. 5,961,768 to Tsujimoto as applied to claim 1 above, and further in view of U.S. Patent No. 5,730,816 to Murphy.

14. With respect to claim 2, the terms “supporting means” and “sticking means” are being treated under 35 U.S.C. 112, sixth paragraph. Okada et al. discloses a lamination device, including a tension control means (4) is disposed between said supporting means (2) and a sticking means (9/10), wherein the tension control means comprises a dancer roller (4), which is movable vertically so as to allow the strip material to be fed out toward said sticking means while giving tension due to its own weight to said strip material (See Figures 1 and 14). However, Okada et al. does not specifically disclose precut means or first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively.

15. Murphy discloses a label stripping apparatus, including first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively (column 4, lines 5-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the first and second sensors taught by Murphy

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with the dancer roller of Okada et al. The motivation would have been to provide more responsive control of the feeding and tension of the tape web.

16. Examiner notes the phrases, “so as to allow the strip material to be fed out toward said sticking means while giving tension due to its own weight to said strip material”, “for detecting a raised position and a lowered position of the dancer roller respectively” and “wherein, when the first sensor detects said dancer roller at the raised position, said supporting means feeds out the strip material by a predetermined amount to lower the dancer roller, and when the second sensor detects the dancer roller at the lowered position, said supporting means stops feeding out the strip material therefrom” are considered intended use language of the currently claimed apparatus. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

### ***Response to Arguments***

17. Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:

18. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pressing rollers which are not "spaced far" from the peeling guide) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

19. With respect to applicant's arguments that the method steps recited in the current means plus function language must be given patentable weight, this argument is not persuasive. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Examiner notes claims 1-2 are drawn to an apparatus, not a method.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791